

application and replete with non-idiomatic English phrases, too numerous to mention, and thus do not lend its lf to a clear understanding of the claimed invention."

Applicant has reviewed the specification at length and does not find justification for the Examiner's contention that the specification is incomprehensible. The specification clearly teaches one of ordinary skill in the art how to make and use the invention. The specification provides an adequate written description of the invention which is enabling.

The specification defines the invention as a bolt having a head that fastens the scaffolding such that the head bolt cannot be moved to loosen its position as is common in conventional devices described in the references of record. The inventive contact surfaces of the bolt prevents a twisting motion when there is tightening of the coupling fasteners.

"The function of the description requirement [of the first paragraph of 35 U.S.C. § 112] is to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him.," In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). "It is not necessary that the application describe the claim limitations exactly. . . . but only so clearly that persons of ordinary skill in the art will recognize from the disclosure that appellants invented processes including those limitations." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976) citing In re Smythe, 480 F.2d 1376, 1382, 178 USPQ 279, 284 (CCPA 1973). Furthermore, the Federal Circuit points out that "[i]t is not

necessary that the claimed subject matter be described identically, but the disclosure originally filed must convey to those skilled in the art that applicant had invented the subject matter later claimed." In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984), cert. denied, 469 U.S. 1209 (1985), citing In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

Applicant respectfully requests the Examiner to point out at least a few samples of the "too numerous" "non-idiomatic English phrases" so that Applicant may adequately address the objection.

Newly added claims 20-39 are definite.

The Examiner contends that claims 20-39 are no different from previously rejected claims 1-19. However, that is in error.

For example, claim 20, newly submitted in the last Response, defines the following features:

Scaffold coupling apparatus for tubular scaffold elements comprising
a first scaffold,
a bolt,
first and second half braces attachable around the scaffold and pivotable around the bolt,
a fastener for tightening the first and second braces,
a second scaffold,
a third brace having a closing mechanism comprising fork-shaped free end-piece,
the third brace holding the second scaffold and being connected to the first and second braces by the fastener,
the fastener comprising bolts having T-shaped heads and bell-shaped projecting parts for limiting a pivotal motion of the T-shaped heads,
a shaft with a nut and threads for fitting in the fork-shaped, free end piece of the third brace,
the T-shaped heads of the bolts fastening the bell-shaped projecting parts, and
contact surfaces for allowing a pivotal motion, for

prev nting jamming inside the proj cting parts and for preventing turning during tightening of the bracing elements.

Applicant respectfully requests the Examiner to point out which of the above defined features are "replete with non-idiomatic English phrases, and phrases lacking antecedent basis."

The Examiner's blanket statement that "The newly submitted claims appear to be replete with the same language" is in error. A comparison of the cancelled claims and the newly submitted claims shows that while Applicant has used pre-existing terminology for the elements defining the invention, the claims have been made to conform with existing patent laws.

The Examiner is aware that the Court of Appeals for the Federal Circuit has long held that an Applicant can be his/her own lexicographer. Therefore, the features defined in the present claims, as for example claim 20 above, are definite, clear and particularly point out the subject matter of the invention.

The Federal Circuit has held that the patent office is obligated to make necessary findings and to provide an administrative record showing the evidence on which the findings are based, accompanied by the agency's reasoning in reaching its conclusion. In re Zurko, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). The decision "must be justified within the four corners of the record." In re Gartside, 53 USPQ2d 1769, 1774 (Fed. Cir. 2000). The Examiner has neither made the necessary findings nor provided any reasoning for the arbitrary conclusion of indefiniteness of

every claim on record.

Applicant respectfully requests the Examiner to point out at least a "sampling" of the so-called "**claims replete with non-idiomatic ... phrases**" so that Applicant can adequately address the rejections.

Claims 20-39 are patentable over Marshall, Miller and Lowe.

The Examiner states:

... applicant had not stated any claimed element not shown by the applied prior art.

Apparently the Examiner is requiring applicant to point out the differences between the claimed invention and each of the references. However, the Examiner has not met the burden of establishing a prima facie case of anticipation of each of the claimed features by each of the references.

The examiner cannot sit mum, leaving the applicant to shoot arrows into the dark hoping to somehow hit a secret objection harbored by the examiner. The 'prima facie case' notion ... was intended to leave no doubt among examiners that they must state clearly and specifically any objections (the prima facie case) to patentability, and give the applicant fair opportunity to meet those objections ... the concept serves to level the playing field and reduces the likelihood of administrative arbitrariness. (emphasis added) In re Oetiker, 25 USPQ2d 1443, 1447 (Fed. Cir. 1992) (Plager, J., concurring); see In re Piasecki, 233, USPQ 785, 788 (Fed. Cir. 1984).

As previously pointed out, Claim 20 describes a scaffold coupling apparatus for tubular scaffold elements comprising a first scaffold, a bolt, first and second half braces attachable around the scaffold and pivotable around the bolt, a fastener for tightening the first and second braces, a second scaffold, a

third brace having a closing mechanism comprising fork-shaped free end-piece, the third brace holding the second scaffold and being connected to the first and second braces by the fastener, the fastener comprising bolts having T-shaped heads and bell-shaped projecting parts for limiting a pivotal motion of the T-shaped heads, a shaft with a nut and threads for fitting in the fork-shaped, free end piece of the third brace, the T-shaped heads of the bolts fastening the bell-shaped projecting parts, and contact surfaces for allowing a pivotal motion, for preventing jamming inside the projecting parts and for preventing turning during tightening of the bracing elements. Dependent claims 21-39 add further unique features to claim 20. Nothing in each of Marshall, Miller or Lowe, describes, teaches or suggests each and every claimed element.

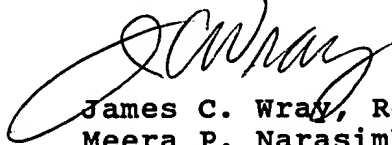
If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent. In re Oetiker, 25 USPQ2d 1443, 1447 (Fed. Cir. 1992) citing In re Grabiak, 226 USPQ 870, 873 (Fed. Cir. 1985).

In fact, the office action does not provide any basis for the rejection of each of the features in every dependent claim and therefore Applicant is unable to determine the Examiner's basis for the rejection of each of the claims to adequately rebut the rejections. It would be mere speculation on Applicant's part to spell out the Examiner's rejections by providing rebuttal to non-existent rejections. Therefore, as dictated by Oetiker

"without more applicant is entitled to grant of the patent."

Since Applicant has presented a novel, unique and non-obvious invention, reconsideration and allowance are respectfully requested.

Respectfully,



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